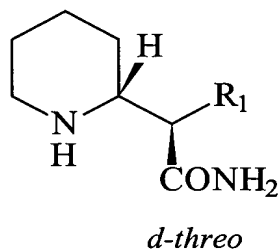
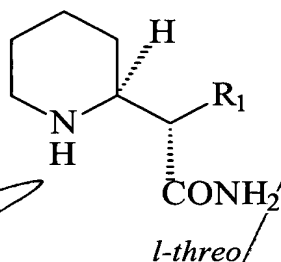


15. A synthetic process for preferentially forming *d-threo* acid salts of *d-threo* piperidyl acetamide stereoisomers with respect to *l-threo* piperidyl acetamide stereoisomers comprising the steps of:

providing a mixture of said *d,l-threo* piperidyl acetamide stereoisomers having formulas:



wherein R<sub>1</sub> is aryl having about 6 to about 28 carbon atoms;

reacting said stereoisomers with an acid resolving agent in an organic solvent, thereby forming acid salts; and

isolating said acid salts.

#### REMARKS

Claims 1-8, 10-13, and 15 are pending in this patent application. Added claim 15 finds support in the specification at, for example, page 11, and is not believe to introduce new matter.

Claims 1-8 and 10-13 stand rejected under 35 U.S.C. § 103 (a) as allegedly being obvious in view of Jursic *et al.*, *Tetrahedron: Asymmetry*, Vol. 5, No. 9, p. 1712 ("the Jursic reference"), in view of Berrang, *et al.*, CA 97:38738 ("the Berrang abstract"), Ohashi, *et al.*, CA 104:186157 ("the Ohashi abstract"), or Vanderplas, *et al.*, CA 118:101538 ("the Vanderplas abstract"), and/or

additional references. Applicants respectfully request reconsideration of these rejections, as the Examiner has still failed to identify any motivating force that would have impelled persons skilled in the art to seek a replacement for the amide-containing resolving agents disclosed in the Jursic reference, much less any motivating force that would have impelled such persons to use one of the organic acids disclosed in, for example, the Berrang reference in place of such amide-containing resolving agents.

The Jursic reference discloses a method for resolving stereoisomers of 2-phenyl-2-(2-piperidyl) acetamide, and stresses the importance of using an *amide-containing* resolving agent. The reference, for example, states that each of the disclosed resolving agents “has specific characteristics that best demonstrate the capabilities of this method” (Jursic reference at 1712). The very next sentence of the Jursic identifies these “specific characteristics” of candidate resolving agents as: (1) high solubility in chloroform; and (2) inclusion of an *amide* group (*id.*).

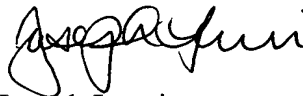
In spite of this explicit teaching in the Jursic reference concerning the need for amide functionality in a resolving agent, the Examiner continues to assert that those skilled in the art would have been impelled by the teaching of the Jursic reference to use a resolving agent in which no such functionality is present. The Examiner, however, has not come forward with any credible reason why any person of ordinary skill without the hindsight provided by Applicants’ disclosure would have been motivated to so drastically modify the teaching of the Jursic reference. Although the Advisory Action notes that the amide-containing resolving agents disclosed in the Jursic reference differ from one another in terms of both their aromatic stacking interactions and the acidity of their respective amide hydrogen atoms, such a disclosure would not have motivated those of ordinary skill

to "discard" the amide groups and use organic acids in their place. Indeed, the Jursic reference teaches that *amide* functionality is the key attribute in a resolving agent, and that the disclosed resolution techniques can tolerate the varying degrees of acidity exhibited by the disclosed class of *amide-containing* compounds. In view of this teaching, Applicants maintain that the skilled artisan would not have been motivated to modify the Jursic disclosure in the manner proposed by the Examiner, would not have been motivated to practice any claimed invention. The rejections for alleged obviousness are therefore improper and should be withdrawn.

Claims 1-8 and 10-13 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Pat. No. 5,936,091. Upon indication of allowable subject matter, Applicants will consider the necessity of filing a terminal disclaimer.

Applicants believe that the claims are now in condition for allowance. An early Office Action to that effect is, therefore, earnestly solicited.

Respectfully submitted,



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